



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,999	07/30/2003	Richard Bodin	22171.353	7723

27683 7590 09/21/2009

HAYNES AND BOONE, LLP

IP Section

2323 Victory Avenue

Suite 700

Dallas, TX 75219

EXAMINER

MATTIS, JASON E

ART UNIT

PAPER NUMBER

2416

MAIL DATE

DELIVERY MODE

09/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,999

Applicant(s)

BODIN ET AL.

Examiner

JASON E. MATTIS

Art Unit

2416

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/23/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 12-14 is/are rejected.
- 7) ☐ Claim(s) 2,10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Appeal Brief filed 6/23/09. Claims 1-20 are currently pending in the application.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 8-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 61-74 of copending Application No. 10/843,402 (hereafter referred to as "app. '402"). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claim 1 of the present application, claim 61 of app. '402 contains every limitation of claim 1 of the present application. While claim 61 of app. '402 does contain extra limitations, claim 1 of the present application merely broadens the scope of claim 61 of app. '402. The omission of an element or step that is not crucial to the invention has been held to be an obvious variation, and thus claim 1 of the present application is not patently distinct from claim 61 of app. '402.

Regarding claim 8 of the present application, claim 62 of app. '402 contains every limitation of claim 8 of the present application. While claim 62 of app. '402 does contain extra limitations, claim 8 of the present application merely broadens the scope of claim 62 of app. '402. The omission of an element or step that is not crucial to the invention has been held to be an obvious variation, and thus claim 8 of the present application is not patently distinct from claim 62 of app. '402.

Regarding claim 9 of the present application, claim 63 of app. '402 contains every limitation of claim 9 of the present application. Claim 9 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 10 of the present application, claim 64 of app. '402 contains every limitation of claim 10 of the present application. Claim 10 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 11 of the present application, claim 65 of app. '402 contains every limitation of claim 11 of the present application. Claim 11 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 12 of the present application, claim 66 of app. '402 contains every limitation of claim 12 of the present application. Claim 12 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 13 of the present application, claim 67 of app. '402 contains every limitation of claim 13 of the present application. Claim 13 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 14 of the present application, claim 68 of app. '402 contains every limitation of claim 14 of the present application. Claim 14 is provisionally rejected under double patenting for the same reasons as claim 8.

Regarding claim 15 of the present application, claim 69 of app. '402 contains every limitation of claim 15 of the present application. While claim 69 of app. '402 does contain extra limitations, claim 15 of the present application merely broadens the scope of claim 69 of app. '402. The omission of an element or step that is not crucial to the invention has been held to be an obvious variation, and thus claim 15 of the present application is not patently distinct from claim 69 of app. '402.

Regarding claim 16 of the present application, claim 70 of app. '402 contains every limitation of claim 16 of the present application. Claim 16 is provisionally rejected under double patenting for the same reasons as claim 15.

Regarding claim 17 of the present application, claim 71 of app. '402 contains every limitation of claim 17 of the present application. Claim 17 is provisionally rejected under double patenting for the same reasons as claim 15.

Regarding claim 18 of the present application, claim 72 of app. '402 contains every limitation of claim 18 of the present application. Claim 18 is provisionally rejected under double patenting for the same reasons as claim 15.

Regarding claim 19 of the present application, claim 73 of app. '402 contains every limitation of claim 19 of the present application. Claim 19 is provisionally rejected under double patenting for the same reasons as claim 15.

Regarding claim 20 of the present application, claim 74 of app. '402 contains every limitation of claim 20 of the present application. Claim 20 is provisionally rejected under double patenting for the same reasons as claim 15.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-9, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Forslow (U.S. Pat. 6608832 B2).

With respect to claim 1, Forslow discloses a method for providing a packet-based multimedia service to a mobile device in a network wherein the service is defined by a telecommunications standard and wherein the network does not support packet quality of service functionality as required by the standard **(See the abstract, column 4 line 61 to column 6 line 33, and Figure 2 of Forslow for reference to a method for providing a packet-based multimedia application flow, which is a service, to a**

mobile station in a wireless packet-switched network 51, wherein the packet switched network 51 does not support a quality of service required by a standard of the application flow). Forslow also discloses establishing a packet signaling connection between the mobile device and network **(See column 6 lines 34-47 and column 10 lines 18-39 of Forslow for reference to establishing a packet-switched bearer service to transport application control messages, which are signaling messages, between the mobile station and the network).** Forslow further discloses establishing a circuit bearer connection between the mobile device and network **(See column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to establishing a circuit-switched bearer service to transport audio and video data).** Forslow also discloses transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard **(See column 6 lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to control messages for the applications being transferred using the packet-switched bearer service in alignment with application standards).** Forslow further discloses transferring data for the multimedia service via the circuit bearer connection in alignment with the standard wherein the multimedia service is provided to the mobile device via the network as specified by the standard even through the network does not support QoS functionality **(See column 6 lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to transferring audio and video data of applications through the circuit-**

switched bearer service to provide the applications to the mobile station as specified by application standards using a course QoS provided by the circuit-switched bearer service even though the network does not support the required QoS functionality).

With respect to claim 3, Forslow discloses controlling the transfer of data via the circuit bearer connection using the signaling information (See column 6 lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to control messages sent via the packet-switched bearer service being used to control the data sent via the circuit-switched bearer service).

With respect to claim 4, Forslow discloses the network requesting the circuit bearer connection (See column 16 lines 51-65 and Figure 10 of Forslow for reference to a GGSN, which is part of the network, selecting and requesting use of a circuit-switched bearer).

With respect to claim 5, Forslow discloses the mobile device initiating a request for the circuit bearer connection (See column 18 lines 22-38 and Figure 11 of Forslow for reference to an embodiment whereby packet header information, which is inserted into data by the mobile station, is used to initiate a request for a circuit-switched bearer).

With respect to claim 6, Forslow discloses maintaining the circuit bearer and packet signaling connections simultaneously (See column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to maintaining

simultaneous a packet-switched bearer service for control data and a circuit-switched bearer service for application data).

With respect to claim 7, Forslow discloses bridging the circuit bearer connection with an endpoint bearer connection establishing a link between the mobile device and the endpoint bearer connection **(See column 9 lines 25-37 of Forslow for reference to using an ISP to bridge data between the mobile station and an end system).**

With respect to claim 8, Forslow discloses a method for providing packet-based multimedia service to an endpoint in a wireless network wherein the service is defined by a telecommunication standard and wherein the network does not support packet quality of service mechanism specified by the standard **(See the abstract, column 4 line 61 to column 6 line 33, and Figure 2 of Forslow for reference to a method for providing a packet-based multimedia application flow, which is a service, to a mobile station, which is an endpoint in a wireless packet-switched network 51, wherein the packet switched network 51 does not support a quality of service mechanism specified by a standard of the application flow).** Forslow also discloses establishing a packet-based signaling context between the endpoint and a gateway **(See column 6 lines 34-47 and column 10 lines 18-39 of Forslow for reference to establishing a packet-switched bearer service to transport application control messages, which are signaling messages, between the mobile station and a MSC, which acts as a gateway).** Forslow further discloses establishing a circuit bearer leg between the endpoint and the gateway using the signaling context **(See column 10**

lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to establishing a circuit-switched bearer service between the mobile station and the MSC to transport audio and video data with the circuit-switched bearer service being control by the control data of the packet-switched bearer service). Forslow also discloses controlling the transfer of data via the circuit bearer leg using the signaling context to control the provision of the packet-based multimedia service via the circuit bearer leg in alignment with the standard **(See column 6 lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to controlling transfer of audio and video data of applications through the circuit-switched bearer service via the packet-switched bearer service to provide the applications to the mobile station in alignment with the application standards).**

With respect to claim 9, Forslow discloses initiating the establishment of the circuit bearer leg by either the endpoint or the gateway **(See column 16 lines 51-65 and Figure 10 of Forslow for reference to a MSC establishing a circuit-switched bearer).**

With respect to claim 12, Forslow discloses providing a codec indicating that a circuit bearer is being used **(See column 6 lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7 of Forslow for reference to indicating that a circuit-switched bearer is being used to transfer some portion of data).**

With respect to claim 13, Forslow discloses provisioning the endpoint with a null codec to prevent voice packets from being sent via an available packet signaling connection **(See column 9 lines 39-53 and column 11 lines 11-28 of Forslow for reference to using only the optimum bearer type for voice packets whereby voice packets are only sent by the mobile station using the circuit-switched bearer service and not the packet-switched bearer service).**

With respect to claim 14, Forslow discloses using a packet-based session initiation protocol **(See column 11 line 56 to column 12 line 10 for reference to the packet-switched bearer using SIP).**

Allowable Subject Matter

7. Claims 2, 10, and 11 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 15-20 are allowed.

Response to Arguments

9. Applicant's arguments, see the Appeal Brief filed 6/23/09, with respect to claims 15-20 have been fully considered and are persuasive. The rejection of these claims under 35 U.S.C. 102 has been withdrawn.

10. Applicant's arguments filed 6/23/09 with respect to claims 1-14 have been fully considered but they are not persuasive.

Regarding Applicant's arguments that Forslow does not disclose signaling information for the multimedia service transferred via the packet signaling connection and data for the multimedia service transferred via the circuit bearer connection, whereby transfer of data via the circuit bearer connection is controlled using the signaling information with the packet signaling connection and circuit bearer connection being maintained simultaneously, as claimed, the Examiner respectfully disagrees. Applicant argues that Forslow discloses selecting either a circuit switched transfer service or a packet switched transfer for each individual application flow. While this is true, it does not preclude Forslow from simultaneously transferring signaling information for a multimedia service via a packet signaling connection and corresponding data for the multimedia service via a circuit bearer connection, as claimed. For example, Forslow discloses breaking an application into separate flows, including a control flow that carries control data for the application, and separately selecting whether to use a packet bearer or a circuit bearer for each of the flows (See column 11 line 56 to column

12 line 34 of Forslow). In this manner the audio and video flows may be transferred via circuit bearers while the control flows for the audio and video flows are transferred via packet bearers. Forslow also discloses that real-time data, such as audio and video, are better transferred via a circuit bearer, while non-real time control data is better transferred via a packet bearer (See column 6 lines 34-38 and column 10 lines 31-39 of Forslow). Thus, Forslow discloses that each flow of an application is separated and serviced using a packet bearer or circuit bearer, as determined appropriate, whereby signaling control data is transferred via a packet bearer, and audio and video data is transferred via a circuit bearer (See column 10 lines 31-53 of Forslow). Therefore, Forslow does disclose simultaneously transferring signaling information via a packet signaling connection and data via a circuit bearer connection, with the transfer of data via the circuit bearer being controlled using the signaling information, as claimed.

Further, Forslow also discusses the problem of conventional packet networks and how the invention of Forslow overcomes this problem. Forslow discloses that in conventional packet networks no special attention is paid to delay or throughput guarantees, and thus applications that require a certain quality of service cannot be guaranteed that quality of service through conventional packet networks (See column 4 line 61 to column 5 line 10). Forslow also discloses that present invention overcomes this problem by breaking applications up into separate flows and selecting a particular type of transfer mechanism for each flow such that the individual flows may be transferred according to individual quality of service requirements of the flows (See column 5 lines 22-36 of Forslow). Therefore, Forslow discloses that a multimedia

Art Unit: 2416

service (the application of Forslow) is provided to the mobile device (the application of Forslow being separated into different flows that are sent to a mobile terminal) via the network as specified by the standard (each separate flow being sent over a selected transfer mechanism according to the individual quality of service requirements of the flow) even though the network does not support the required QoS functionality (where the conventional packet network alone cannot provide quality of service guarantees of the application as a whole), as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON E. MATTIS whose telephone number is (571)272-3154. The examiner can normally be reached on M-F 8AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason E Mattis
Primary Examiner
Art Unit 2416

JEM

/Jason E Mattis/
Primary Examiner, Art Unit 2416